



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,490	06/26/2003	Wataru Satake	KON-1803	5669
20311	7590	05/19/2004	EXAMINER	
MUSERLIAN AND LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 05/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/606,490	SATAKE, WATARU
	Examiner	Art Unit
	Hoa V. Le	1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 April 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) Claim(s) 1,2,4 and 9-11 is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 5-8 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 June 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

This is in response to Papers filed on 20 May 2004.

I. The following is an examiner's statement of reasons for allowance:

(A) For the broadly claimed of the ratio of sodium to potassium ion with the language "at least" being included and considered as infinite amount of sodium ions as compared to one potassium ions. A careful studying of the instant application unveils there is no unusual or unexpected result for a patentability of the claimed as the broadly claimed. Tappe et al show that sodium and potassium ions are used in an alternative or substitution that is also conventional, known and practiced in the art at least as about the broadly claimed. Applicant should show or provide a convincing evidence to the contrary.

(B) The record shows that:

"Applicants' declaration under Rule 132 filed on 04 February 2004 has been fully considered but is insufficient to overcome the applied references of the record. The evidence is not commensurate in scope with the claims (Please see MPEP 716.02(d)).

(1) Tappe et al composition in Example 4 shows quality result. Please see Applicant's showing in Table A. At the level of one skilled in the art, the quality result as shown in Table A would be better than those of any and all broadly claimed compositions. Applicant should and is urged and requested to show an evidence to the contrary for a complete and timely consideration and examination during the prosecution of this application. A claim would have no value if someone later show it. It is noted that applicant shows the advantages of Examples 2-5 and 2-12.

(2) However, the instant claims have not been reasonably limited to the tested condition

of high temperature as tested and urged with at least 50⁰C, length of time for storage as tested and urged at least 3 months and specific chemical ingredients and their relative proportion as tested and urged. There is no evidence on the record that any and all broadly claimed composition would be able to provide an advantage over Tappe et al composition in Example 4. Applicant should and is urged and requested to show an evidence to the contrary. In the absence of convincing evidence, no value should be given to about (up to -2 and +2% of each individual value and no more than 7% for the total – and + changes in value) the limited tests for Examples 2-5 and 2-12.

(3) The showings in Table A as compared to Examples 2-5 and 2-12 are not a side-by-side comparison with respect to the specific chemical ingredients and their relative proportion. Accordingly, they have and are given no value.

(4) It would like to see test results to be carried out at about 0.001 mg/l of the requisite additive chemical ingredients as broadly claimed other than the concentration of the main color developing agent.

(5) It would also like to see test result to be carried out using the adjacent homologue A-II-3 and A-II-9 as disclosed in the instant application.

For the above reasons the showings are incomplete and much limited in scope than those as broadly claimed”.

© Applicants' declaration under Rule 132 filed on 20 April 2004 has been fully considered but is insufficient to overcome the applied references of the record. The evidence is

not commensurate in scope with the claims (Please see MPEP 716.02(d)).

(1) Applicant shows the use of compounds A-II-3 and A-II-9 being better than that of EDTA as applied to the limited showing of Tappe et al Example 4 only.

(2) However, the instant claims have not been reasonably limited to the tested condition of high temperature as tested and urged with at least 50⁰C, length of time for storage as tested and urged at least 3 months and specific chemical ingredients and their relative proportion as tested and urged.

(3) The elected, considered, searched and examined material claims is allowable with a general assumption that each and all broadly claimed limitations would be able to provide about the same (up to -2 and +2% of each individual value and no more than 7% for the total – and + changes in values) value as limited tests for patentability of the claims only.

Applicant should show or provide a convincing evidence to the contrary. In the event that Applicant could be able to show or provide a convincing evidence to the contrary. An allowance may be withdrawn as shown or provided. Another rejection Office may be made. Additional showings to each and all broadly claimed limitations may be requested.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

II. This application is in condition for allowance except for the following formal matters:

Applicant is requested to canceled the non-elected invention of claims 5-8 to put the instant application in a condition for an allowance.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

III. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/606,490
Art Unit: 1752

Page 6

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
18 May 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le